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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,766	07/10/2000	James L. Hepworth	040246-002000US	8887

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EXAMINER

LY, ANH

ART UNIT PAPER NUMBER

2162

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/612,766

Applicant(s)

HEPWORTH ET AL.

Examiner

Anh Ly

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2007.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
4a) Of the above claim(s) 3,4,6-16,19,20,22-27 and 30-34 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,2,5,17,18,21,28 and 29 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 3/9 & 4/3/07.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is response to Applicant's AMENDMENT filed on 04/03/2007.
2. Claims 3-4, 6-16, 19-20, 22-27 and 30-34 have been cancelled.
3. Claims 1-2, 5, 17-18, 21 and 28-29 are pending in this Application.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-2 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 6,401,118 B1 issued to Thomas in view of US Patent No.: 6,611,830 B2 issued to Shinoda et al. (hereinafter Shinoda).

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With respect to claim 1, Thomas teaches a method of searching and reporting an incidence of at least one of a trademark, a tradename, a celebrity name, or famous name to be searched in a web page on the Internet (receiving search requests from users on a web client and a sever for searching the Internet for URL's including information InterNIC: abstract, fig. 3 and col. 6, lines 28-62 and col. 11, lines 30-42), comprising:

receiving, from a user, the at least one trademark, tradename, celebrity name, and/or famous name to be searched in the Web page on the Internet (abstract and col. 6, lines 28-62);

automatically creating a search string based on the at least one trademark, tradename, celebrity name, and famous name entered by the user ();

receiving a URL address of the Web page on the Internet to be searched (fig. 3, col. 6, lines 28-52);

accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, wherein the searched contents includes elements other than only a domain name (search result or hits is returned based on the search request matching the search criteria in the search request: col. 1, lines 55-67 and col. 2, lines 15-35); and

providing search results of identified matches in the contents of the Web page corresponding to the search string, wherein the search results are extracted from the Web page, categorized, and formatted in a report, each category including at least one character string corresponding to a number of occurrences of the identified matches

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within the category, the category selected from the group consisting of a meta-tag, a hidden text, a text, a title, a hyperlink, and an image text, and wherein the report displays the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text, and wherein the search results highlight the at least one trademark, tradename, celebrity name, or famous name found in the Web page and wherein the at least one trademark, tradename, celebrity name, or famous name to be searched is provided in an encrypted connection authenticated by a certificate server (the output of the search request is displayed in the fig. 3, see col. 11, lines 30-67 and col. 16, lines 40-67).

Thomas teaches receiving search request or search string and sending the search request to web server for searching the Internet for URL's including InterNIC. And the result is displayed as a report with column as fig. 6. Thomas does not clearly teach determining an unauthorized use of the at least one trademark, tradename, celebrity name, or famous name.

However, Shinoda teaches an unauthorized user to modifying the trademark or famous name over a network (col. 1, lines 40-46 and col. 6, lines 42-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined the teachings of Thomas and Shinoda. One having ordinary skill in the art would have found it motivated to utilize the use of determining the use of trademark from the user over network as disclosed (Shinoda's col. 6, lines 42-67), into the system of Thomas for the purpose of searching

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data over the Internet network, thereby, preventing unauthorized the copies of trademark to be sent over Internet (Shinoda's col. 1, lines 8-10 and lines 40-46).

With respect to claim 2, Thomas teaches wherein the at least one character string is a number of the identifying matches within the category (containing content matching the search criteria: abstract and col. 2, lines 38-50).

With respect to claim 17, Thomas teaches wherein the search contents include at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles and images (fig. 6 and col. 16, lines 40-67).

7. Claims 5, 18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Claims 1-2 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 6,401,118 B1 issued to Thomas in view of US Patent No.: 6,611,830 B2 issued to Shinoda et al. (hereinafter Shinoda) and further in view of Pub. No.: US 2002/0156774 A1 of Beauregard et al. (hereinafter Beauregard).

With respect to claim 5, Thomas teaches a method of searching and reporting an incidence of at least one of a trademark, a tradename, a celebrity name, or famous name to be searched in a web page on the Internet (receiving search requests from users on a web client and a sever for searching the Internet for URL's including information InterNIC: abstract, fig. 3 and col. 6, lines 28-62 and col. 11, lines 30-42), comprising:

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receiving, from a user, the at least one trademark, tradename, celebrity name, and/or famous name to be searched in the Web page on the Internet (abstract and col. 6, lines 28-62);

automatically creating a search string based on the at least one trademark, tradename, celebrity name, and famous name entered by the user (');

receiving a URL address of the Web page on the Internet to be searched (fig. 3, col. 6, lines 28-52);

accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, wherein the searched contents includes elements other than only a domain name (search result or hits is returned based on the search request matching the search criteria in the search request: col. 1, lines 55-67 and col. 2, lines 15-35); and

providing search results of identified matches in the contents of the Web page corresponding to the search string, wherein the search results are extracted from the Web page, categorized, and formatted in a report, each category including at least one character string corresponding to a number of occurrences of the identified matches within the category, the category selected from the group consisting of a meta-tag, a hidden text, a text, a title, a hyperlink, and an image text, and wherein the report displays the at least one character string in a column format for at least one of the meta-tag, the hidden text, the text, the title, the hyperlink, and the image text, and wherein the search results highlight the at least one trademark, tradename, celebrity name, or famous name found in the Web page and wherein the at least one trademark,

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tradename, celebrity name, or famous name to be searched is provided in an encrypted connection authenticated by a certificate server (the output of the search request is displayed in the fig. 3, see col. 11, lines 30-67 and col. 16, lines 40-67).

Thomas teaches receiving search request or search string and sending the search request to web server for searching the Internet for URL's including InterNIC. And the result is displayed as a report with column as fig. 6. Thomas does not clearly teach determining an unauthorized use of the at least one trademark, tradename, celebrity name, or famous name.

However, Shinoda teaches an unauthorized user to modifying the trademark or famous name over a network (col. 1, lines 40-46 and col. 6, lines 42-67).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Shinoda to the system of Thomas for the user-entered search request or search string including InterNIC information to search in the Web page on the Internet in order to get the search result based on the user-entered search query/string. Thomas and Shinoda do not teach automatically creating homonyms and phonetic for the at least one trademark, tradename, celebrity name or famous name entered by user.

However, Beauregard teaches word dictionary for lookup and checking spelling including homonyms or phonetic or synonyms (sections 0265, 0278 and 0373).

Therefore, based on Thomas in view of Shinoda, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize the teachings of Beauregard to the system of Thomas for the constructing homonyms and

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phonetic of the at least one trademark, tradename, celebrity name or famous name entered by the user. The motivation being for detecting and correcting the search query entered by user from misspellings in search attempts, thereby, allowing a user to access via a set of defined words a plurality of services in order to have an efficient, convenient and natural way to utilize his/her language to work with application (Beauregard's section 0003 and 0022).

With respect to claim 18, Thomas teaches wherein the search contents include at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles and images (fig. 6 and col. 16, lines 40-67).

With respect to claim 21, Thomas teaches wherein the at least one character string is a number of the identifying matches within the category (containing content matching the search criteria: abstract and col. 2, lines 38-50).


With respect to claim 28, Thomas teaches wherein the information relating to the owner of the URL address conducting the unauthorized use includes a name and an address of the owner (see fig. 6 and col. 16, lines 40-67).


With respect to claim 29, Thomas in view of Shinoda teaches wherein informing the owner of the unauthorized use includes delivering a cease and desist letter (Shinoda's col. 1, lines 40-46, col. 6, lines 48-65; also see fig. 5-6 and 9-10; col. 4, lines 46-62 and col. 7, lines 15-62).

Contact Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh Ly whose telephone number is (571) 272-4039 or via E-Mail: ANH.LY@USPTO.GOV (**Written Authorization being given by Applicant (MPEP 502.03 [R-2])**) or fax to (571) 273-4039 (**Examiner's personal Fax No.**). The examiner can normally be reached on TUESDAY – THURSDAY from 8:30 AM – 3:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **John Breene**, can be reached on (571) 272-4107.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Any response to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, or faxed to: **Central Fax Center: (571) 273-8300**

ANH LY 
APR. 15th, 2007


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